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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT PAPER NUMBER

3726

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/062,832

**Applicant(s)**LEHNER-DITTENBERGER,  
STEFAN**Examiner**

Marc Jimenez

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/20/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-29 is/are pending in the application.
- 4a) Of the above claim(s) 10-12,14,18-22,25 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9,13,15-17,23,24 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01262004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Species A, Subspecies I, Subspecies iii, claims 1, 2, 5-9, 13, 15-17, 23, 24, and 27-29 in the response filed 2/20/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 10-12, 14, 18-22, 25, and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the response filed 2/20/04.

### *Specification*

3. The amendment filed 9/29/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "Figs. 1-3 illustrate that support point 26 is a ring 26 placed over base body 14. As discussed above ring 26 is rigid and is in contact with base body 14 and resilient tube 30, thereby partially supporting resilient tube 30."

Applicant is required to cancel the new matter in the reply to this Office Action.

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***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1, 2, 5-9, 13, 15-17, 23, 24, and 27-29** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation “at least one rigid support ring into which said base body is inserted added to claim 1 constitutes new matter. There is no support in the original disclosure for a rigid support ring into which the base body is inserted. The original disclosure only describes that “rigid support points” (numeral **26** in applicant’s drawings) are formed, at least partially, by the base body itself (page 3, lines 19-20 of applicant’s specification).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. **Claims 1, 2, 5-8, 13, 15, and 17** are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson (4,974,782).

Nelson teaches a roller for winding of a material web thereon, the roller having two roller ends and a mid roller area, the roller having a maximum winding diameter associated therewith, the roller comprising: a base body **35** being substantially cylindrical, at least one rigid support ring **60a** into which the base body **35** is inserted, at least one resilient member **60**, the at least one resilient member **60** being at least one resilient element **60** (fig. 3) positioned on the base body **35**, the at least one resilient member **60** being positioned and configured so as to make the roller radially more resilient near each of the roller ends than in the mid-roller area (abstract, last five lines) in order to at least partially compensate for a deflection of the base body **35** at the maximum winding diameter, the roller has a roller length, each resilient member **60** having a radial rigidity, the radial rigidity of each resilient member **60** varying over the roller length (abstract, last five lines), and a circumferential surface **30** positioned over the base body **35**, the circumferential surface **30** contacting the material web, the circumferential surface **30** in contact with the at least one rigid support ring **60a**, the circumferential surface **30** being one of integral with and separate from the at least one resilient member **60**.

Regarding claim 2, the material web being a paper web does not further limit the structural features of the claimed roller and therefore has not been given patentable weight. Furthermore, it is noted that it is inherent that the roller of Nelson is used for paper webs because it is used for pressure treating sheets in imaging systems (col. 1, lines 9-12 and col. 2, lines 60-63). Also, It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art

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apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 5-7, note that there are rigid support points at the mid point of the base body **35** and axially along the base body which are surrounded by the circumferential surface **30**, the circumferential surface **30** being radially less resilient in a vicinity of the rigid support point on the mid point than near the two roller ends (abstract, last two lines). The claimed "rigid support points" have no defined structure, but are merely "points" along the base body.

Regarding claim 8, the circumferential surface **30** comprises a resilient tube surrounding the base body **35**, the at least one resilient member **60** being positioned radially between the base body **35** and the resilient tube **30**.

Regarding claim 13, the at least one resilient member **60** is a resilient layer, the resilient layer **60** being a layer comprised of one of rubber and another elastomeric material (col. 2, lines 4-8).

Regarding claim 15, the circumferential surface **30** comprises a resilient tube surrounding the base body **35**, the at least one resilient member **60** being a resilient layer, the resilient layer **60** being provided near the two roller ends and being positioned between the base body **35** and the resilient tube **30**.

Regarding claim 17, the at least one resilient member **60** is a resilient layer, the resilient layer **60** having a constant thickness over an axial length thereof, the resilient layer **60** increasing in radial resilience toward each of the two roller ends (abstract, last five lines), the resilient layer **60** being applied on the base body **35** at least near each of the two roller ends.

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***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 9, 16, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson.

Regarding claims 9 and 16, Nelson teaches the invention cited with the exception of the resilient tube being a coating of rubber or another elastomeric material.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Furthermore, on page 3, last two lines to page 4, first line of applicant's specification, the particular use of resilient material could be metal, rubber, or other similar material. Therefore, at the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used rubber or other elastomeric material for the tube, because applicant has not disclosed that using rubber or other elastomeric material provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the

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metal tube taught by Nelson or the claimed resilient tube material because either type of material for the tube perform the same function of covering the resilient member equally well. Therefore, it would have been an obvious matter of design choice to modify Nelson to obtain the invention as specified in claims 9 and 16.

Regarding claim 23, Nelson teaches the invention cited with the exception of the base body **35** being hollow. Official notice is taken that it was well known in the art to a person of ordinary skill in the art, to have used a hollow base body in order to reduce the weight of the base body.

10. **Claims 24 and 27-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Pessen (3,750,246).

Nelson teaches the invention cited above (see also fig. 1) with the exception of having tension anchors.

Pessen teaches tension anchors **H** (col. 7, lines 14-33).

It would have been obvious to one of ordinary skill in the, at the time of the invention, to have provided the invention of Nelson with tension anchors, in light of the teachings of Pessen, in order to securely hold the resilient layer in place. Note that Pessen also teach spacers **92**.

Regarding claim 27, Pessen teaches at least two outer walls **92** (one on each side of the roller) with the tension anchors braced by the outer walls.

Regarding claim 28, Pessen teaches that the tension anchors **H** are braced in a rectangular manner by the spacer **92**.

Regarding claim 29, Pessen teach a spacer **92**.



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Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Nelson with the features of claims 27-29, in light of the teachings of Pessen, in order to securely hold the resilient layer in place.

### ***Response to Arguments***

11. Applicant's arguments filed 9/29/03 have been fully considered but they are not persuasive.

12. In response to the 35 U.S.C. 112, first paragraph rejection stating that the limitation "ring" added to the claims constitutes new matter, applicant has proposed to amend the specification so that the limitation "ring" is added to the disclosure. It is noted however, that the original disclosure has no support for the limitation "ring" and therefore this limitation constitutes new matter. The original disclosure only has support "rigid support points" as described in the original disclosure at page 3, lines 19-20 of applicant's specification. The original disclosure was not so specific that the rigid support points have to be "rings".

13. Applicant argues that because the element to the right of lead line 70a in fig. 4 of Nelson is disclosed as made of elastomeric material as stated in lines 7-9 of column 3 and that the very nature of elastomeric material is compressible and is therefore not rigid. It is noted, however, that the centermost ring 60a or 70a in fig. 3-4 is described as having the most rigidity compared with the rings outward of the center ring as described in col. 4, lines 2-3. The ring is also made of solid material (col. 3, line 25). Solid material is considered "rigid".

14. Applicant's arguments with respect to claims 2, 5-6, 13, 15-17, 23, 24, and 27-29 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define

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a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant merely state that these claims are dependent on claim 1.

15. Applicant's arguments with respect to claims 10-12, 14, 18-22, 25, and 26 are moot since these claims have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention

### ***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Interviews After Final***

17. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the

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interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

***Contact Information***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (703) 306-5965. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Marc Jimenez  
Patent Examiner  
AU 3726

**MJ**  
May 29, 2004